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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,643	09/30/2003	Stephen H. Roby	T-6172 (538-52)	4801

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EXAMINER	
ANTHONY, JOSEPH DAVID	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/674,643	ROBY ET AL.	
	Examiner	Art Unit	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) *32-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 32-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/26/06. The examiner asserts that to examine the non-elected invention would be an undue burden on the examiner, and the examiner is in a far better position to make this decision then is applicant who is not examining the application. Furthermore, the reasons for the restriction as set forth by the examiner are deemed to be valid since applicant has wholly failed to show any proof that the alternate method of use proposed by the examiner will not work. The restriction is thus made Final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 15 are indefinite because it is unclear of what the relationship is between the reaction product prepared by "transesterfying at least one glycerol ester" and "at least one non-glycerol polyol ester". Is the "at least one non-

glycerol polyol ester" a reactant in the transesterfying of the "at least one glycerol ester" or is it a separate distinct component?

Independent claims 1 and 15 are also indefinite in regards to what is meant by: "a major amount of a base oil" and "a minor deposit-inhibiting effective amount of . . .". What are the metes and bounds of the terms "major amount" and "minor amount"? According to applicant's specification on page 10, an example of a major amount of a base oil is an amount of "at least 40 wt. %". This is not a definition of what a "major amount" is but only an example of a major amount.

Dependent claims 2-14 and 16-31 are rejected here because they are dependent on rejected base claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 15-16, 18-19 and 26-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Chiu et al. U.S. Patent Application Publication Number 2003/0186824A1.

Chiu et al. teach a biodegradable lubricant that is at least 60% biodegradable and has a gelation index of about 12 or less can be formulated using transesterified triglyceride base oil together with a synthetic ester. A combination of an ester viscosity index improver and an olefin copolymer viscosity index improver also can be added. Further, the composition can be blended with mineral oils to lower the polarity in order to employ standard dispersant/inhibitor packages. Further, by mixing high and low viscosities of mineral oil in the formulation, it is possible to prepare a full range of SAE

grade engine oils for gasoline-fueled and diesel-fueled engines, see abstract. The disclosed transesterfied triglycerides are deemed to read directly on applicant's component (b). Applicant's claims are deemed to be clearly anticipated over the reference, see Table 2, sections [0035]-[0061], [0092]-[0093] and the examples.

7. Claims 7-14, 17 and 20-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chiu et al. U.S. Patent Application Publication Number 2003/0186824A1.

Chiu et al has been described above and is deemed to anticipated applicant's claimed invention. In the alternative, Chiu et al may differ from applicant's claimed invention in that it is unclear if there is a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's particular claimed species of component (b) within applicant's particular claimed concentration ranges. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's particular claimed species of component (b) within applicant's particular claimed concentration ranges since such directly fall within the broad disclosure of the reference as cited above.

8. Claims 1-10, 15-21, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Culpon, Jr. U.S. Patent Number 5,151,205.

Culpon, Jr. teaches a lubricating composition has been found for chain and gear drive mechanisms. The composition comprises a polyalphaolefin base oil, an ester oil

solubilizer and 2 to 4 wt % of a polybutene tackifier. The composition replaces a mineral oil formulation and demonstrates persistent lubricity and substantially reduced smoking in chain and drive gear assemblies operated at high temperatures, see abstract. Applicant's claims are deemed to be anticipated over Examples 1-3.

9. Claims 11-14 and 22-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Culpon, Jr. U.S. Patent Number 5,151,205.

Culpon, Jr. has been described above and is deemed to anticipated applicant's claimed invention. In the alternative, Culpon, Jr. may differ from applicant's claimed invention in that it is unclear if there is a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration ranges. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration ranges since such directly fall within the broad disclosure of the reference.

10. Claims 1-11, 15, 18-22, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. teach oils containing a triacylglycerol polyol ester and a non-glycerol polyol ester are described, as well as methods of making such oils. Methods for

improving lubrication properties of a vegetable oil also are described see abstract. Applicant's claims are deemed to be anticipated over the patent, see examples 3-5, and column 5, line 20 to column 7, line 18.

11. Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. has been described above and is deemed to anticipated applicant's claimed invention. In the alternative, Kodali et al. may differ from applicant's claimed invention in that it is unclear if there is a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration ranges. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since such directly falls within the broad disclosure of the reference.

12. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lal U.S. Patent Number 5,338,471 in view of anyone of the following: Chiu et al. U.S. Patent Application Publication Number 2003/0186824A1 or Culpon, Jr. U.S. Patent Number 5,151,205 or Kodali et al. U.S. Patent Number 6,278,006.

Lal teaches This invention relates to a composition containing the combination of: (A) at least one vegetable or synthetic triglyceride, (B) esters from the transesterification of at least one animal or vegetable oil triglyceride, (C) a pour point depressant, and (D) a performance additive. The composition may optionally contain (E) other oils, see abstract. Lal differs from applicant's lubricating oil composition in that Lal component "(B) esters from the transesterification of at least one animal or vegetable oil triglyceride" appear to be different from applicant's claimed component (b) because Lai transesterfying process is different from applicant's transesterfying process.

The secondary references to Chiu et al., Culpon, Jr. and Kodali et al. have all been described above.

It would have been obvious to one having ordinary skill in the art to use the direct teaching of anyone of the secondary references to Chiu et al., Culpon, Jr. and Kodali et al. as strong motivation to actually use their transesterfied product in lieu of or in addition to the transesterfied products directly disclosed by Lai for the benefits that these oxidative stable transesterfied products are taught to have. To use the transesterfied products, as taught by the secondary references, in applicant's claimed concentration ranges is also deemed to be obvious since the secondary references directly disclose these concentration ranges broadly.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/674,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is massive overlap in the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 11/046,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap in the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior-Art Cited But Not Applied

16. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

Examiner Information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

Joseph D. Anthony

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

7/6/06